

### **III. REMARKS**

#### **Status of the Claims**

Claims 1-10 are presented for further consideration. Claim 7 is amended to correct a typographical error in the last amendment.

#### **Summary of the Office Action**

Claims 1 and 2, and 5-10 stand rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, G.B. Patent No. 2,294,844 in view of the disclosure of Bridges, et al, U.S. Patent No. 6,546,246 and further in view of the reference Sainton, et al, U.S. Patent No. RE38787. Claims 3 and 4 stand rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, in view of the disclosures of Bridges and Sainton, and in further view of the reference Henry, Jr. et al, U.S. Patent No. 5,603,084. The Examiner is respectfully requested to reconsider his rejection in view of the following remarks.

#### **Discussion of the Cited References**

The examiner continues to rely primarily on the reference van den Heuvel, et al as the primary support for the rejection of all of the claims on the basis of obviousness. It is acknowledged that van den Huevel fails to teach that the subscriber unit will store identification information. The reference Bridges is cited to remedy this deficiency. In addition it is acknowledged that the combined teachings of van den Huevel and Bridges further fails to teach receiving data over a common system parameter channel from a local one of said independent, globally dispersed networks in to which the mobile station has traveled.

The acknowledged deficiencies of the teaching of van den Huevel and Bridges are not remedied by the teaching of the newly cited reference Sainton for the reasons stated below. The Examiner is attempting to combined systems that are significantly different in operation. There is nothing in these disclosures that would encourage a person

skilled in the art to pick minor components of each reference to construct the system of this application. Applicant submits that this application is being used as template to obtain the system described in the claims under consideration.

As previously indicated, the reference van den Heuvel teaches a system for providing a selection process for a subscriber to allow the use by a subscriber of certain features available in multiple communications systems 11-17 coupled together by a common wireline system 18. It requires an initial contact with a common system 19 to receive information on available networks and their features. The subscriber may select a desired network and feature, download the required software, and then contact the selected network. This does not describe a system that is global in scope, but only local. There is no capability for performing the functions from data stored on the mobile phone, but it is totally reliant on the service of the common system.

Accordingly, there are two intermediate entities required in the system of van den Heuvel, that are not required in the system of this invention, namely, wireline system 18, and a common communication system 19. The system of van den Heuvel is, therefore, limited in its application and cannot provide the globally adaptive function of the subject invention.

The rejection under 35USC103(a) combines the teaching of van den Heuvel in combination with the reference Bridges. The reference Bridges involves a system by which a mobile station, in roaming mode, may access another wireless network that has a preferred status by virtue of a prearrangement with the home provider. This is described in the reference Bridges, beginning at column 8, line 51 through column 9, line 1, as follows:

**"The present invention relates to a mobile station with intelligent roaming and/or over-the-air programming features. The present invention permits a mobile station to immediately obtain service on a preferred cellular, PCS or other wireless network system meeting a subscriber's service requirements.**

**The selection or designation of such a system carrier may be configured to comply with, for example, preferences of a corporation having a National Account with the home wireless carrier, when there are multiple bands available.**

**According to an aspect of the present invention, a Preferred System Identification List (PSL) (for cellular systems) and/or an Intelligent Roaming Database Downloading (IRDB) (for cellular, PCS and other wireless systems) is stored within a memory or storage device of the mobile station. When the mobile station is roaming, the PSL or IRDB is accessed to indicate the band where the mobile station will find a preferred system."**

The system requires a list of preferred service providers, it does not contemplate service access through independent, globally dispersed cellular networks. In addition, there is no indication of how or why the teaching of Bridges could be combined with the system of van den Heuvel. There is no processing of data received from a cellular system that is compiled with operational data of a mobile phone to form a matrix from which an operational structure can be formed according to predetermined criteria.

To remedy the deficiencies of the teachings of van den Heuvel and Bridges, the Examiner cites the new reference Sainton and characterizes the teaching of Sainton as follows:

**"A system is selected based on the user preferences or a preprogrammed routine by the unit (column 16, lines 32-58), which reads on the claimed, 'independent, globally dispersed networks into which the mobile stations the mobile stations have traveled, wherein said data is received directly without reliance on any local area network or wireline system'"**

Applicant respectfully submits that the Examiner is mistaken. The system of Sainton is limited to a network of wireless service providers that permit the borrowing of radio frequencies among the wireless service providers of the network. This network includes service providers within the same geographic region. This is clear from the abstract and the excerpt from Sainton cited by the Examiner, wherein Sainton indicates, at column 16, lines 28-30 as follows:

**"As described above, circuit 1 will be capable of utilizing any one of the wireless data services within a given geographic area."**

and in the Abstract as follows:

**"A network and method of operating a network of wireless service providers adapted to interact with a plurality of omni-modal wireless products within a given geographic area in a manner to permit the wireless service providers to "borrow" radio frequencies from other wireless service providers within the same geographic region." (emphasis added)**

The system of Sainton allows the borrowing of frequencies among service providers so that, as a cellular service provider in a given region experiences demands that overload its system, available frequencies may be borrowed from a competitive service serving the same region.

Based on the above description in Sainton, it is clear that the system of Sainton is not equipped for use among independent globally dispersed networks as the Examiner has indicated. The combined teachings of van den Heuvel, Bridges and Sainton fail to support prima facie obviousness. The systems of van den Heuvel, Bridges, and Sainton are limited in their use and cannot provide the globally adaptive function of the subject invention.

To obtain a teaching of the system described in the claims of this application, the Examiner requires the person skilled in the art to pick over the combination of the multiple communications systems of van den Heuvel, coupled together by a common wireline system and requiring an initial contact with a common system; with the system of Bridges involving a system by which a mobile station, in roaming mode, may access another wireless network that has a preferred status by virtue of a prearrangement with the home provider; and the system of Sainton that allows the borrowing of frequencies among service providers in a given region. Applicant submits that the only common

thread among these references is the subject application and that, to advocate this combination as obvious to one skilled in the art, is a misapplication of the doctrine of obviousness.

### **The Issue of Obviousness**

It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. The combination of references fails to disclose several features of the claims because of the limitations of the disclosure of van den Heuvel. For example in claim 1, the following feature is required:

**"a transceiver for receiving data over a common system parameter channel from a local one of said independent, globally dispersed networks into which the mobile stations has traveled, wherein said data is received directly without reliance on any local area network or wireline system;"**

None of the references either individually or in combination disclose or could use such a transceiver. Equivalent language is contained independent claim 8.

Applicant submits that the above described deficiencies of the primary reference van den Heuvel are not remedied by the proposed combination with the teachings of the references Bridges and Sainton or Henry. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of the cited references, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.

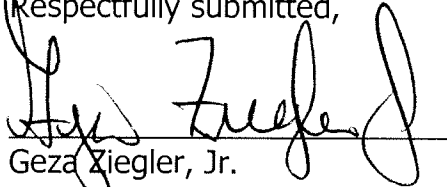
The above arguments apply equally to the rejected dependent claims.

In view of the remarks stated above, Applicant submits that all of the claims under

consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for the three-month extension of time (1020.00) as well as any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

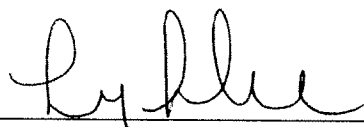
  
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11 September 2006  
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